

Appl. No. 09/965,960
Amdt. dated September 13, 2005
Reply to Office action of June 20, 2005

REMARKS/ARGUMENTS

Applicants have received the Office action dated June 20, 2005, in which the Examiner: 1) rejected claim 9 under 35 U.S.C. § 112, 2nd paragraph, as being indefinite; 2) rejected claims 1-4, 10, 11, 20-22, 40, 44-46 and 48-50 under 35 U.S.C. § 102(b) as being anticipated by Kenichi (JP 08251660); 3) rejected claims 5-9, 12, 23-27, 35-39 and 41-43 under 35 U.S.C. § 103(a) as being unpatentable over Kenichi and further in view of Menezes et al. ("Handbook of Applied Cryptography"); and 4) rejected claims 13-17 and 28-32 under 35 U.S.C. § 103(a) as being unpatentable over Kenichi and Menezes and further in view of Schneier et al. (U.S. Pat. No. 5,956,404). With this Response, Applicants have amended claims 1, 4, 9, 18, 19, 23, 25, 32-36, 40, and 45, canceled claims 2, 3, 24, and 44, and submitted new claims 52-64. Based on the arguments and amendments contained herein, Applicants believe this case to be in condition for allowance.

The § 112, 2nd paragraph, rejection of claim 9 has been addressed via amendment.

The Examiner used Kenichi in the art rejection of all claims. At the outset, Applicants feel compelled to point out that the Kenichi reference is a Japanese language document that has been translated into English. The quality of the translation is very poor and consequently Applicants struggle to fully understand its teachings. From the URL provided at the bottom of the page of the Kenichi patent, the translation appears to have originated from the JPO/NCIPI website which provides computer-generated translations and a disclaimer that translations may not be accurate.

At any rate, Kenichi seems to disclose a system by which a user can access an information center 14 to report that a portable radio terminal 11 has been stolen and to request that a lock command be transmitted to the stolen terminal 11. Upon receipt of the lock command, the terminal erases "all of the contents" of a random access memory (RAM). See e.g., Abstract of Kenichi.

Applicants amend method claim 1 to require "performing an action on said portable electronic device in response to said security message, said action

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selected from a group consisting of causing a short circuit, placing the portable electronic device in a mode in which a function of the portable electronic device is disabled, operating memory at an incorrect clock rate, causing said portable electronic device to report its location, and precluding access to data stored in the portable electronic device." Kenichi does not disclose or even teach any of the listed actions recited in claim 1. Instead, Kenichi teaches a complete erasure of all contents of memory. For at least this reason, claim 1 and all claims dependent thereon are patentable.

Some claims dependent from claim 1, for example, claims 5-9 and 12, include various aspects of encryption, digital signatures, and the like. For example, claim 5 states that the method comprises "digitally signing said security message." The Examiner recognizes that Kenichi is deficient in this regard and, instead, turns to Menezes. Menezes, however, is simply a handbook on the general topic cryptography. It is improper for the Examiner to use Menezes in rejecting the claims.

The Federal Circuit has made clear that "[i]t is impermissible to use the claimed invention as an instruction manual...to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (reversing the examiner's rejection on this basis). Federal Circuit case law strongly admonishes against piecing together the prior art by using an applicant's teachings in hindsight. This is so because it is well known that most, if not all, inventions are combinations of known limitations. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985) ("35 U.S.C. § 103 requires that obviousness be determined with respect to the invention as a whole. This is essential for combination inventions, for generally all combinations are of known elements.").

Of course, the concept of encrypting a piece of data or digitally signing something in and of itself is not new to Applicants. What is new are limitations involving encryption, digital signatures, etc. as recited in claims 5-9 and 12 in combination with the other claim features. The Examiner has done nothing other than establish that encryption, for example, by itself is not new. The Examiner,

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however, must go beyond that to establish a prima facie case of obviousness. With regard to claims 5-7, for example, the Examiner states that it would have been obvious to use Meneze's general explanation of digital signatures to the security message of Kenichi for the purpose of "authentication, authorization, and non-repudiation." Applicants were trying to provide authentication and authorization to the subject matter at hand. Thus, the Examiner has used Applicants' teachings against the Applicants in clear violation of Federal Circuit case law. Claims 5-9 and 12 are allowable for this additional reason as well.

Newly added claim 52 depends from claim 1 and comprises "determining which of a plurality of entities initiated said security message and selecting the action based on the determined entity." None of the art of record teaches or even suggests selecting the actions of claim 1 based on which entity is determined to have initiated the security message. Kenichi, for example, simply teaches that an entity causes a lock command to be sent to the radio terminal and the radio terminal erases all of its memory. Kenichi does not permit a different action to be selected if a different entity initiates the lock command.

Claim 23 is directed to a portable electronic device that has been amended as shown. Claim 23 is allowable for much the same reason as claim 1 and thus that reasoning is not repeated. All claims dependent from claim 23 are allowable as well at least for the same reasoning as claim 23. Some claims dependent from claim 23 have limitations related to encryption and digital signatures. Such claims were rejected as obvious using Menezes in combination with Kenichi. For the reasoning expressed above, Menezes cannot be used in the rejection of such claims.

Claims 38 and 39 explain that the "decryption key cannot be overwritten" and that the "decryption key cannot be copied." The Examiner apparently did not find these limitations in any art of record, and instead took "official notice" that such limitations are well known. Applicants disagree that such limitations are well known and request the Examiner to support his position.

Claims 40-43, 45-46, and 48-51 are patentable for much the same reasons discussed above.

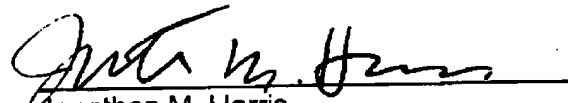
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New claim 53 is directed to a portable electronic device that requires that the CPU "receives a security message from one of a plurality of entities and selecting a destructive action to be performed in said portable electronic device based on a determination as to which entity sent the security message." None of the art of record has such a teaching. Dependent claims 54-58 each provide a specific example of a "destructive action." Applicants do not find any of these destructive actions in the art of record.

Method claims 59-64 are patentable for much the same reasons discussed above regarding claims 53-58.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



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